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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/781,280   | 02/17/2004  | Masaki Nakamura      | 56232.98            | 2036             |
| 7590   | 08/25/2005  |                      | EXAMINER            |                  |
| Squire, Sanders & Dempsey L.L.P.<br>One Maritime Plaza, Suite 300<br>San Francisco, CA 94111 |             |                      | FAISON, VERONICA F  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1755                |                  |

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/781,280             | NAKAMURA ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Veronica F. Faison     | 1755                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 June 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,8,9 and 12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4,8,9 and 12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

Claims 1-4, 8 have been amended, and claims 5-7, 10 and 11 have been canceled and claim 12 has been added. Hence, claims 1-4, 8, 9 and 12 are pending in the application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sacripante et al (US Patent 6,025,412).

Sacripante et al teach an ink composition comprising particles of an emulsifiable dye-polymer resin dispersed in a liquid vehicle, wherein the emulsifiable dye-polymer resin includes a dye chemically attached to the polymer resin. The polymer resin comprises a base chain, such as polyester having attached thereto hydrophilic groups such as alkali sulfonated groups from emulsifying the resin in water. The reference further teaches that the dye may be attached with the base chain itself or attached to the base chain as a side chain component (abstract, col. 3 line 64-col. 4 line 35). The dye used in the ink composition may be any suitable commercially available dye, however the preferred dyes include anionic, cationic, reactive and alcohol- and oil-soluble dyes (col. 6 line 46+). The reference remains silent to the color cyan, however it

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would have been obvious that one of ordinary skill would know that among the dyes listed that a cyan color can be produced having the properties set forth in claim 1. The polymer resin comprises from about 20 to 50 mole percent dye residue by weight of the polymer resin (col. 8 lines 62-67). The colored particulates having dye bonded to a polymer resin may have a number average particle size of from about 2 nm to about 500 nm (col. 9 lines 29-36). Sacripante et al fails to specifically exemplify the use of cyan colored polymer particles as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the specific cyan colored polymer particles as claimed by applicant as Sacripante et al also discloses the use of cyan colorants but shows no example incorporating them in the polymer particles.

Claims 1-3, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurabayshi (US Patent 6,790,878).

Kurabayshi teaches ink composition comprising either pigment having a cationic group, or a pigment and a pigment dispersant having a cationic group and a resin encapsulating a coloring material and further teaches that the ink composition may be used in an ink set with at least one other ink wherein the color of the ink may be selected from yellow, magenta, cyan, black, red, green and blue (col. 4 lines 44-65 and col. 6 lines 6-24). The reference further teaches that the average particle diameter of the resin encapsulating the coloring material is within a range of from 0.01 to 2.0  $\mu\text{m}$  (col. 7 lines 63-67 and col. 11 lines 17-20). Kurabayshi fails to specifically exemplify the use of cyan colored polymer particles as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the specific cyan colored polymer

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particles as claimed by applicant as Kurabayashi also discloses the use of cyan colorants but shows no example incorporating them in the polymer particles.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VFF  
8-17-05

J. A. LORENZO  
SUPERVISORY PATENT EXAMINER

